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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Paul Schimmel et al.	)	
Application No.	09/813,718	)	
Filed:	March 21, 2001	)	
		)	Group Art Unit: 1642
For:	HUMAN AMINOACYL-tRNA SYNTHETASE POLYPEPTIDES USEFUL FOR THE REGULATION OF ANGIOGENESIS	)	
Examiner	Gary B. Nickol, Ph.D.	)	Attorney Docket No. TSRI 817.0

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RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
Washington, D. C. 20231

Sir:

In response to the requirement for restriction set forth in the Office Action dated 2 July 2002 on the above-identified application the applicants provisionally elect for prosecution at this time the claims of Group I, i.e., claims 1-8 and 36-37, inclusive, drawn to isolated polypeptides and compositions thereof. This election is made with traverse.

Reconsideration of the present 12-way Restriction Requirement is requested.

Applicants respectfully submit that at least Group V should be examined together with the elected Group I. The claims of Group V are also drawn to isolated peptides and compositions thereof, and should be classified in Class 530, subclass 350, inasmuch as the claimed polypeptides have more than 100 amino acid residues.

The present Restriction Requirement should be withdrawn also because it is not in compliance with 35 U.S.C. §121 and 37 C.F.R. §1.141. 35 U.S.C. §121 provides that the Commissioner may restrict an application when "two or more independent and distinct inventions are claimed in a single application." (emphasis added). Similarly, 37 C.F.R. §1.141 (a) permits restriction conditioned upon the finding that independent and distinct inventions are found within a single application. There is no indication that Groups I and V are independent, however.

In fact, applicants submit that these two groups are not independent. For two or more inventions to be considered independent, there must be no disclosed relationships between the inventions in question, i.e., they are unconnected in design, operation or effect. M.P.E.P. §802.01. The subject matter in Group V is also directed to truncated tryptophanyl-tRNA synthetase polypeptides but is restricted to mammalian polypeptides.

Therefore, it is clearly evident that these two groups of claims have a disclosed relationship and are, therefore, not independent. In light of the foregoing statutory and regulatory criteria, the present Restriction Requirement cannot be maintained since the inventions are not independent from one another.

Furthermore, the Restriction Requirement is not in compliance with the M.P.E.P. It is well established that the Office Action must provide a rationale on the record to support a Restriction Requirement. More specifically, M.P.E.P. §808 states:

> The requirement to restrict has two aspects, (1) the reasons (as distinguished from the mere statement of conclusion) why the invention as claimed are either independent or distinct and (2) the reasons for insisting upon restriction therebetween.... (emphasis in original).

In the present case, the Office Action has failed to show or provide adequate reasoning to support the Restriction Requirement. The Office Action concludes that each group represents a separate and distinct invention, without providing adequate evidence in support thereof. More specifically, the Office Action cites no reference or teaching that supports the allegation in the Office Action that the claims in the various groupings are patentably distinct. Consequently, the Restriction Requirement is not in compliance with M.P.E.P. §808, and withdrawal thereof is respectfully requested.

It is also noted that the Requirement for Restriction is not mandatory under 35 U.S.C. §121 and 37 C.F.R. §1.142 but is merely discretionary. This observation is particularly important in light of court decisions which have indicated that an improperly made Restriction Requirement would not preclude a holding of double patenting, despite the language of 35 U.S.C. §121, third sentence. See, for example, Eversharp, Inc. v. Phillip Morris, Inc., 256 F. Supp. 778, 150 U.S.P.Q. 98 (E.D.Va. 1966); aff'd 374 F.2d 511, 153 U.S.P.Q. 91 (4th Cir. 1967). Therefore, to promote the interest of both the public as well as the applicants, the Restriction Requirement should not be imposed without a specific analysis

which supports the conclusions that two or more independent and distinct inventions are indeed claimed in one application.

In addition, the courts have recognized the advantages of the public interest to permit patentees to claim all aspects of their invention, as the applicants have done herein, so as to encourage the patentees to make a more detailed disclosure of all aspects of their invention. The Court has observed:

> We believe that the constitutional purpose of the patent system is promoted by encouraging applicants to claim, and therefore to describe in the manner required by 35 U.S.C. § 112, all aspects of what they regard as their invention, regardless of the number of statutory classes involved.

In re Kuehl, 177 U.S.P.Q. 250, 256 (C.C.P.A. 1973).

Furthermore, applicants respectfully submit that in view of increased Official Fees and the need to file divisional applications substantially concurrently, a practice which arbitrarily imposes a Restriction Requirement may become cost prohibitive, and thereby contravenes the constitutional intent to promote and encourage the process of science and the useful arts.

Hence, it is respectfully requested that the Examiner reconsider and withdraw the Restriction Requirement, and provide an action on the merits with respect to all of the claims.

Respectfully submitted,

August 13, 2002

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